

Summary of Office Action

As an initial matter, Applicants note that the Office Action Summary incorrectly states that only claims 11-28 are pending in the application, and that only claims 11-28 have been acted on in the present Office Action. Applicants respectfully submit that with the Amendment filed November 13, 2003 two additional claims were submitted for consideration by the Examiner, i.e., claims 29 and 30. Accordingly, should the Examiner intend to reject these additional claims 29 and 30 as well, it is respectfully requested that the next Office Action be made non-final so as to provide Applicants with a full and fair opportunity to deal with the corresponding rejection.

Claims 11-28, i.e., all claims considered in the Office Action, are rejected under 35 U.S.C. § 102(b) and 102(e), respectively, as allegedly being anticipated by each of JP 05-057507 (hereafter “KYOCERA”), U.S. Patent No. 5,945,207 to KUTSCHER et al. (hereafter “KUTSCHER”) and U.S. Patent No. 5,861,210 to LEANDER et al. (hereafter “LEANDER”).

Response to Office Action

Reconsideration and withdrawal of the rejections of record are respectfully requested.

***Response to Rejection of Claims under 35 U.S.C. 102(b) over KYOCERA***

Claims 11-28 are rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by KYOCERA. This rejection is exclusively based on page 2, lines 4-13 of the electronic English language translation of KYOCERA and alleges that this passage discloses “the claimed roughness and the claimed structure”.

This rejection is respectfully traversed. In this regard, Applicants note that the present independent claims recite, *inter alia*,

- (a) a surface roughness (Rmax) of 0.2  $\mu\text{m}$  or less
- (b) substantially at a blade-edge ridge and in a region which extends at least 200  $\mu\text{m}$  (500  $\mu\text{m}$ ) from a rake face side boundary of the ridge toward a rake face side, and extends at least 50  $\mu\text{m}$  (200  $\mu\text{m}$ ) from a flank side boundary of the ridge toward a flank side.

The passage of KYOCERA relied on in the rejection appears to merely recite a surface roughness of 0.4  $\mu\text{m}$  or less and is completely silent as to the extension of the region within which this surface roughness is to be 0.4  $\mu\text{m}$  or less. In this regard, it is further noted that the results summarized in e.g., Table I at page 12 of the present application illustrate that there is a difference in technical terms between a roughness of 0.4  $\mu\text{m}$  or less and a roughness of 0.2  $\mu\text{m}$  or less. In other words, both of the above elements (a) and (b) are neither disclosed nor suggested in KYOCERA. For at least this reason, KYOCERA does not anticipate any of the claimed subject matter. Accordingly, withdrawal of the rejection of the claims under 35 U.S.C. § 102(b) over KYOCERA is warranted and respectfully requested.

***Response to Rejection of Claims under 35 U.S.C. 102(e) over KUTSCHER***

Claims 11-28 are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by KUTSCHER. This rejection relies on column 3, line 42, to column 4, line 12, of KUTSCHER and alleges that this passage discloses “the claimed coating structure within the claimed thickness having the claimed roughness within the claimed blade edge ridge”.

This rejection is respectfully traversed as well. In particular, KUTSCHER appears to merely disclose a surface roughness of 0.4  $\mu\text{m}$  or less (col. 4, lines 4-9), i.e., not a surface roughness of 0.2  $\mu\text{m}$  or less as recited in the present independent claims. Further, KUTSCHER does not appear to disclose any size of the region within which the surface roughness is to be 0.4  $\mu\text{m}$  or less. It is noted that in column 4, line 7, of KUTSCHER a “length of 10  $\mu\text{m}$ ” is mentioned. However, it appears that this length is a reference length (which in the present independent claims is indicated to be 5  $\mu\text{m}$ ). Accordingly, KUTSCHER does not anticipate any of the claimed subject matter for at least the stated reasons. In view thereof, the rejection of claims 11-28 under 35 U.S.C. § 102(e) over KUTSCHER should be withdrawn, which action is respectfully requested.

***Response to Rejection of Claims under 35 U.S.C. 102(e) over LEANDER***

Claims 11-28 also are rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by LEANDER. This rejection does not identify any passage of LEANDER, but merely alleges that this document discloses the “claimed coating structure within the claimed thickness and a smooth alumina coating on the claimed blade edge ridge”, wherefore the claimed smoothness is considered to be inherent. Accordingly, the rejection acknowledges that the claimed smoothness is not explicitly disclosed in LEANDER. Regarding the alleged inherent disclosure of a smoothness of 0.2  $\mu\text{m}$  or less, the Examiner is respectfully reminded that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993). See also MPEP § 2112. Applicants note that the present Office Action does not explain why the material of

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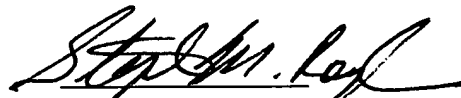
LEANDER necessarily has a surface roughness of 0.2  $\mu\text{m}$  or less.

At any rate, even if it were assumed, *arguendo*, that LEANDER inherently discloses a surface roughness of 0.2  $\mu\text{m}$  or less, this document clearly does not disclose the size and location of the area in which this surface roughness is present. For the above reasons alone, the rejection of claims 11-28 under 35 U.S.C. § 102(e) over LEANDER is without merit, wherefore withdrawal of this rejection is warranted as well, and respectfully requested.

#### CONCLUSION

In view of the foregoing, it is believed that all of the claims in this application are in condition for allowance, which action is respectfully requested. If any issues yet remain which can be resolved by a telephone conference, the Examiner is respectfully invited to telephone the undersigned at the telephone number below.

Respectfully submitted,  
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